



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,140	11/04/2003	Tongbi Jiang	303.343US9	4829
21186 7590 06/13/2007 SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER LAMB, BRENDA A	
			ART UNIT 1734	PAPER NUMBER
			MAIL DATE 06/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/701,140

Applicant(s)

JIANG ET AL.

Examiner

Brenda A. Lamb

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8-15 and 17-21 is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1734

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification fails to teach or suggest a stencil having a first coating applied to one surface of the stencil pattern and one or more side surfaces of the stencilling openings and having a surface tension greater than the surface tension of the stencil pattern; and a second coating applied to the opposite surface of the stencil pattern and having a surface tension less than the surface tension of the stencil pattern wherein at least one of the first coating and second coating includes the means for controlling a running property of an adhesive.

The recitation that "at least one" of the first coating and second coating of the stencil includes the means for controlling a running property of an adhesive is open with the term "comprising" to the stencil having more than a first and second coating which includes the means for controlling a running property of an adhesive which presents new matter since the originally filed specification fails to teach or suggest that the stencil has more than two types of coating – one having a surface tension greater than the

Art Unit: 1734

stencil pattern and another coating having a surface tension less than the surface tension of the stencil pattern.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is confusing since it is unclear whether applicant is claiming the second coating or the first coating in its entirety provides the means for controlling the running property of the adhesive or a component of the second coating or first coating provides the means for controlling the running property of the adhesive. Note if applicant is claiming the second coating in its entirety provides the means for controlling the running property of the adhesive then an objection of claim 16 under 37 CFR 1.75 as being a substantial duplicate of claim 11 will follow in the next office action. When one employs means plus function language in a claim such as means for controlling for controlling a running property of an adhesive as set forth in claim 16 then applicant must set forth in the specification adequate disclosure showings what is meant by that language. If applicant fails to set forth an adequate disclosure, then applicant has failed to particularly point out and distinctly claims the invention required by the second paragraph of section 112. See *in re Donaldson Co.* 16 F.3d 1189, 1195 29 USPQ2d 1845, 1850 (FED. CIR.1994). Note if the means for controlling the running property of

Art Unit: 1734

the adhesive is a polymeric material then an objection of claim 16 under 37 CFR 1.75 as being a substantial duplicate of claim 4 will follow in the next office action.

Applicant's arguments filed 2/23/2007 have been fully considered but they are not persuasive.

Applicant's argument that page 10 lines 5-15 provides support for the second coating including means for controlling a running property of an adhesive is found non-persuasive. It is noted that applicant is silent as whether the second coating or the first coating in its entirety provides the means for controlling the running property of the adhesive or a component of the second coating or first coating provides the means for controlling the running property of the adhesive and therefore unclear what the means for controlling a running property of an adhesive encompasses and therefore the rejection of claim 16 under 35 USC 112, second paragraph is maintained. When one employs means plus function language in a claim such as means for controlling for controlling a running property of an adhesive as set forth in claim 16 then applicant must set forth in the specification adequate disclosure showings what is meant by that language. If applicant fails to set forth an adequate disclosure, then applicant has failed to particularly point out and distinctly claims the invention required by the second paragraph of section 112. See *in re Donaldson Co.* 16 F.3d 1189, 1195 29 USPQ2d 1845, 1850 (FED. CIR.1994).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday. The examiner can also be reached on alternate Wednesdays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached on (571) 272-1231. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1734

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Brenda A Lamb". The signature is fluid and cursive, with the first name "Brenda" being more prominent than the last name "Lamb".

Brenda A Lamb

Examiner

Art Unit 1734